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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,953	12/02/2005	Philippe Marliere	261089US0XPCT	5311
22850	7590	03/19/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ZEMAN, ROBERT A	
			ART UNIT	PAPER NUMBER
			1645	
			NOTIFICATION DATE	DELIVERY MODE
			03/19/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/510,953	<b>Applicant(s)</b> MARLIERE ET AL.	
	<b>Examiner</b> ROBERT A. ZEMAN	<b>Art Unit</b> 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 46 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 1-45 and 48-52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. It should be noted that claims 23-24 constitute non-statutory use claims and as such have been withdrawn from consideration. Hence they are not included in the restriction set forth below.

Group I, claim(s) 1-4, 9-16 and 25-29, drawn to polynucleotides with the polynucleotide sequence of SEQ ID NO:X or encoding for a polypeptide with the amino acid sequence of SEQ ID NO:X.

Group II, claim(s) 5-8, 17-23 and 33, drawn to polypeptides with the amino acid sequence of SEQ ID NO:X or encoded by a nucleic acid with the polynucleotide sequence of SEQ ID NO:X.

Group III, claim(s) 24, drawn to a DNA chip comprising at least a polynucleotide with the polynucleotide sequence of SEQ ID NO:X.

Group IV, claim(s) 30-32, drawn to methods of producing a polypeptide with the amino acid sequence of SEQ ID NO:X.

Group V, claim(s) 34-35, drawn to antibodies that bind to a polypeptide with the sequence of SEQ ID NO:X.

Group VI, claim(s) 36 (in part), drawn to a protein chip comprising a polypeptide with the amino acid sequence of SEQ ID NO:X.

Group VII, claim(s) 36 (in part), drawn to a protein chip comprising an antibody that binds to a polypeptide with the amino acid sequence of SEQ ID NO:X.

Group VIII, claim(s) 37, drawn to method of detecting cyanophage S-2L or related phage utilizing a polynucleotide with the polynucleotide sequence of SEQ ID NO:X.

Group IX, claim(s) 38-44, drawn to methods of obtaining D-bases and/or polynucleotides of interest .

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Group X, claim(s) 45 (in part), drawn to a method for selecting compounds capable of stimulating the synthesis of D-bases

Group XI, claim(s) 45 (in part), drawn to a method for selecting compounds capable of inhibiting the synthesis of D-bases

Group XII, claim(s) 45 (in part), drawn to a method for selecting compounds capable of stimulating the synthesis of polynucleotides

Group XIII, claim(s) 45 (in part), drawn to a method for selecting compounds capable of inhibiting the synthesis of polynucleotides

Group XIV, claim(s) 48, drawn to the strain of cyanophage S-2L deposited at the CNCM under the accession number I-2619.

Group XV, claim(s) 49, drawn to a method of producing a gene bank.

Group XVI, claim(s) 50, drawn to the gene bank of the cyanophage S-2L deposited at the CNCM under the accession number I-2619.

Group XVII, claim(s) 51, drawn to the plasmids contained in the cyanophage S-2L deposited at the CNCM under the accession number I-2619.

Group XVIII, claim(s) 50, drawn to recombinant bacteria such as that deposited at the CNCM under the accession number I-2619.

### **Additional Election Requirement Applicable to Groups I-VIII**

In addition, each of Groups I-VIII reads on patentably distinct SEQ ID Numbers. Each sequence is patentably distinct because the sequences are structurally unrelated sequences, and a further restriction is applied to each Group. Applicant must further elect a single SEQ ID NO. (See MPEP 803.04).

**Applicant is advised that examination will be restricted to only the elected SEQ ID NO and combination (if applicable) and should not to be construed as a species election.**

The inventions listed as Groups I-XVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R. 1.475(d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first

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mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly, the main invention (Group I) comprises the first recited **product**, a polynucleotide with the sequence of SEQ ID NO:X. Further pursuant to 37 C.F.R. 1.475(d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT rule 13.2 and that each of such products and methods accordingly defines a separate invention. Moreover, given that the fragments recited in claim 2 are known in the art (said fragments read on fragments as small as a dimer and hence are encompassed by random primer kits), there is no unifying technical feature that makes a contribution to the art. Consequently, there is no unity of invention

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined

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claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT A. ZEMAN whose telephone number is (571)272-0866. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on (571) 272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert A. Zeman/  
Primary Examiner, Art Unit 1645  
March 6, 2008